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08/802,472	02/18/1997	CHARLES KORMANIK JR.		7544
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PETER K TRZYNA P O BOX 7131 CHICAGO, IL 606807131			LUBY, MATTHEW D	
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 08/802,472
Filing Date: February 18, 1997
Appellant(s): KORMANIK, CHARLES

Peter Tryzna
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 4, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that the claims do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

3,624,939	GOSSARD	12-1971
Des. 346,185	FRANCIS	04-1994
Des. 196,679	SCHAFFER	10-1963

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 5, 9, 11, 13, 20, 22, 28, 30 and 31 are rejected under 35 U.S.C. 102(b) by Gossard. This rejection is set forth in a prior Office Action, mailed on 12/02/03.

Claims 8, 10, 12, 14 and 15 are rejected under 35 U.S.C. 103(a) by Gossard. This rejection is set forth in a prior Office Action, mailed on 12/02/03.

Claims 17 and 49 are rejected under 35 U.S.C. 103(a) by Gossard in view of Francis. This rejection is set forth in a prior Office Action, mailed on 12/02/03.

Claim 18 is rejected under 35 U.S.C. 103(a) by Gossard. This rejection is set forth in a prior Office Action, mailed on 12/02/03.

Claim 23 is rejected under 35 U.S.C. 103(a) by Gossard in view of Schaffer. This rejection is set forth in a prior Office Action, mailed on 12/02/03.

Claim 29 is rejected under 35 U.S.C. 103(a) by Gossard. This rejection is set forth in a prior Office Action, mailed on 12/02/03.

Claims 51, 53, 55 and 57 are rejected under 35 U.S.C. 103(a) by Gossard. This rejection is set forth in a prior Office Action, mailed on 12/02/03.

(11) *Response to Argument*

Claim 5

Applicant first argues that "Gossard is silent as to anything being done with the photographs after removal from the container, and Gossard shows photographs, but

does not mention the activities of collecting sports memorabilia or collecting signatures" (page 14, lines 2-4). The Examiner's response to this argument is that the claim does not require that anything be "done with the photographs [i.e., the article] after removal from the container". Claim 5 is a method claim. It is a method claim for constructing a package and article contained therein. Therefore any claim limitation as to what the article or package are used for, either together or separately, goes to intended use. Intended use type limitations in a method claim are given no patentable weight. In response to applicant's argument, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicant second argues that "Gossard does not mention or suggest the claimed method step of: constructing ... the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package..." (page 14, lines 18-22). The Examiner's response is that lines 5-6 of claim 5 are extremely broad and therefore require, in turn, an extremely broad interpretation. As mentioned in the previous paragraph, claim 5 is a method claim for constructing a package and article contained therein. The only impact of lines 5-6 of claim 5 is to limit the shape that the package and article may take. This can be met by virtually any

package having a shape that is suggestive of some type of activity, wherein the article is capable of use during that activity. The figures of Gossard do teach this.

Applicant third argues that "Gossard is silent as to ...making a combination... for combined marketing and the claimed marketing step" (page 18, lines 20-21). The Examiner's response is that the claim limitation of "marketing the combination" merely requires "selling" the combination. Since there would be no point in making something for profit and then not selling it, the Gossard product must be marketed. This extremely broad limitation when justly interpreted extremely broadly, is met by Gossard.

Claims 8-15

In response to Applicant's arguments as to the various (in the Examiner's opinion, non-patentably distinguishable) species of the shape of the package (in claims 9-15), it is still the Examiner's opinion that these are mere changes within the scope of design choice. The Applicant has offered no reason as to why the shapes in claims 8, 10, 12, 14 and 15 solve a different problem than the shapes in claims 9, 11 and 13. They have merely rehashed their argument that a stated problem is solved by making a thematic package and have not persuasively argued that the specific shapes in claims 8, 10, 12, 14 and 15 solve a problem different in scope from the package shapes of claims 9, 11 and 13. Indeed, the commonality of these claims, and the only patentable link is that the claims require a) forming a package; b) that the package have a shape that suggests to the user (entirely subjective by the way) an activity in which the shape has some connection; c) forming an article which also has some connection to the activity; d) locating the article in the package and e) selling this package plus the article.

Claim 20

Applicant argues that "Gossard is equally silent with regard to the claim requirement of constructing the package to have additional utility independent from containing said article" (page 25, lines 16-17). This limitation is another intended use recitation, i.e., that the package will have some type of intended use utility other than containing the article therein and is not a positively, set-forth method step. In other words, the only additional thing that claim 20 adds to claim 5 is what the package may be used for once it is formed. There can be no more clear-cut example of intended use. Intended use type limitations in a method claim are given no patentable weight. In response to applicant's argument, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the invention of Gossard can clearly be used as a toy, for example, and this is a utility that is "independent from containing [the] article."

Claim 22

Applicant actually argues on pages 26-28 that "[n]othing on Gossard teaches a method step involving a substance capable of receiving subsequent writing from a pen or magic marker" (quoted portion in the paragraph bridging pp. 27-28). Gossard does

disclose a method for making a package and article contained therein where the package is "capable" of receiving writing from a magic marker or a pen, as one could write on the outside surface of the packages shown in the figures of Gossard with either a pen or magic marker.

Claim 28

Applicant argues Gossard does not teach locating another article within the hollow. Since figures 2 and 5 of Gossard show multiple articles, this limitation is met.

Claim 30

In response to Applicant's argument regarding claim 30, the same logic applied to Applicant's argument regarding claim 5 applies.

Claim 31

Regarding claim 31, Applicant argues that the separate pieces of the package shown in Figures of Gossard, which are pivotally joined together do not meet the limitation "constructing the package as having seperably joinable pieces". Figure 2 shows this limitation, i.e., seperably joinable pieces (11 and 12).

Claim 18

Regarding claim 18, Applicant argues that it is not an obvious matter of design choice to add an outer layer of packaging shaped to visually suggest information about the associated activity (i.e., adding a plastic bubble enclosing the contents for sale in a store). The Examiner does not agree and maintains the position of the final rejection as to claim 18 (Final Rejection, paragraph 17, pp. 6-7).

Claim 29

Regarding claim 29, Applicant argues that it is not obvious to one having ordinary skill in the art at the time the invention was made to make the replica and article out of plastic. The Examiner does not agree and maintains that is obvious to do so as this has been a readily available, inexpensive material since the 1960's and since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Claims 51, 53, 55 and 57

Regarding claims 51, 53, 55 and 57, Applicant argues that mere duplication is not design choice. The only difference between claim 51 and claim 5 is that more than one combination is being made. The Examiner could not find a more perfect example of mere duplication and does not agree that this isn't an obvious matter of design choice.

Claims 17 and 49

Regarding claims 17 and 49, Applicant argues that the Franics reference does not teach these obvious limitations and that Francis is non-analogous art. Firstly, regarding the argument that Franics does not teach locating a logo on the package or imprinting a message on the package that is suggestive of the use of the article, Applicant is referred to the words "Card Football" shown in the Figure of Francis. This is a logo and is also a message on the package of Franics that is suggestive of the use of the article therein, namely, football cards (it is suggestive because it tells a user exactly what is in the package and therefore lets the user know what activities they may use the article for). Secondly, regarding the argument that Franics is non-analogous art, it has

Art Unit: 3611

been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Francis and Gossard are reasonably pertinent to the particular problem with which the applicant was concerned (i.e., packaging that is not merely packaging but rather takes on some shape for which the article therein may be related to). Both Francis and Gossard are shaped like sports balls.

Claim 23

Applicant argues that Schaffer is non-analogous to Gossard. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Schaffer and Gossard are reasonably pertinent to the particular problem with which the applicant was concerned (i.e., packaging that is not merely packaging but rather takes on some shape for which the article therein may be related to). Both Schaffer and Gossard are shaped like sports balls.

For the above reasons, it is believed that the rejections should be sustained.

Art Unit: 3611

Respectfully submitted,

Matt Luby
Examiner
Art Unit 3611

M.J.

M.I.
October 14, 2004

Conferees

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